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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/607,920	06/27/2003	Christopher M. Edwards	ED 002	8110

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EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/607,920

Applicant(s)

EDWARDS, CHRISTOPHER M.

Examiner

Brian K. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 1-5 and 8-16 are objected to because of the following informalities: In claim 1, line 6, there is no antecedent basis for "said body", a suggested correction is "said body portion". In claim 1, lines 6-7, there is no antecedent basis for "said tab portion", a suggested correction is "said tabs". In claim 14, line 8, there is no antecedent basis for "said body", a suggested correction is "said body portion". In claim 8, line 9, there is no antecedent basis for "said tab portion", a suggested correction is "said tabs". Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisatomi et al. (U.S. Patent No. 5,177,890).

Hisatomi et al. shows in figures 10-12 a flat tile (50) of a flexible, elastic material (see column 6, lines 6-29) having a body portion in the shape of a parallelogram and tabs (the portions extending outwardly from each of the grooves 52 on each of the sides). Hisatomi et al. discloses the applicant's basic inventive concept in figures 10-12 except for whether the sides are 1 to 2-3/8 inches and the tabs extending 1/4 to 3/4 inches from the sides. It would have been obvious to one in the art to modify Hisatomi et al. by making the sides 1 to 2-3/8 inches and the

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tabs $\frac{1}{4}$ to $\frac{3}{4}$ inches since this would allow the tiles to be secured to a wire mesh fence and further it is considered within one skilled in the art to make the sides and tabs any size as desired. The size of the tabs would vary based upon the diameter of the wire used to make the fence. On large diameter wired fences the tabs would be "about $\frac{1}{4}$ inches". Also, the Federal Circuit has held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984). In regard to claim 2, Hisatomi et al. discloses in column 6, lines 23-27 that the tiles are deformable by hand. In regard to claim 3, Hisatomi et al. discloses in column 6, lines 10-15 that the tiles are formed of a synthetic resin. In regard to claim 4, Hisatomi et al. shows in figure 10 that the tiles are generally square shaped. In regard to claim 8, it is considered within one skilled in the art to modify Hisatomi et al. by making the thickness of the tiles between .005 to .075 inches since this would allow the tiles to be flexible enough to flex onto the wire mesh and it is it considered within one skilled in the art to vary the thickness of the tiles as desired. In regard to claim 9, the tiles (50) are placed within openings in the wire mesh. In regard to claim 10, the wire mesh is a chain link fence. In regard to claims 13 and 15, Hisatomi et al. shows in figure 1 the idea of forming a pattern, design, or symbol with the tiles. In regard to claim 16, as broadly defined, the tiles attach paint or dyes to the wire mesh, see column 8, lines 25-34. The paint or dyes are considered to be the object attached to the wire mesh.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horton (U.S. Patent No. 2,111,780).

Horton shows in figures 1-4 a flat tile (9) of a flexible, elastic material (see page 1, column 1, lines 51-55 and column 2, lines 1-5) having a body portion in the shape of a parallelogram and tabs (in figure 4, tabs 10,11,12). Horton discloses the applicant's basic inventive concept in figure 4 except for whether the sides are 1 to 2-3/8 inches and the tabs extending 1/4 to 3/4 inches from the sides. It would have been obvious to one in the art to modify Horton by making the sides 1 to 2-3/8 inches and the tabs 1/4 to 3/4 inches since this would allow the tiles to be secured to a support surface shown in figure 1 in a secure manner and further it is considered within one skilled in the art to make the sides and tabs any size as desired. Also, the Federal Circuit has held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984). In regard to claim 2, the tiles are deformable by hand.

Claims 1,2, and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newell, Jr. (U.S. Patent No. 1,004,810).

Newell, Jr. shows in figure 9 a flat tile (17) of a flexible, elastic material (sheet metal is known to be flexible and elastic) having a body portion in the shape of a parallelogram and tabs (18,18,19,19). Newell, Jr. discloses the applicant's basic inventive concept except for whether

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the sides are 1 to 2-3/8 inches and the tabs extending 1/4 to 3/4 inches from the sides. It would have been obvious to one in the art to modify Newell, Jr. by making the sides 1 to 2-3/8 inches and the tabs 1/4 to 3/4 inches since this would allow the tiles to be secured to a given sized wire mesh and further it is considered within one skilled in the art to make the sides and tabs any size as desired. Also, the Federal Circuit has held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984). In regard to claim 2, the tiles are deformable by hand. In regard to claim 2, the tiles are deformable by hand. In regard to claim 9, the tiles (17) are placed within openings in the mesh and as shown in figures 1 and 6 substantially cover the openings. In regard to claim 8, it is considered within one skilled in the art to modify Newell, Jr. by making the thickness of the tiles between .005 to .075 inches since this is within the range of the typical thickness of sheet metal and it is it considered within one skilled in the art to vary the thickness of the tiles as desired. In regard to claim 10, the wires (23,24) form a mesh which is considered to be a "chain link fence". In regard to claim 11, the body portion is substantially square. In regard to claims 13 and 15, Newell, Jr. shows in figures 1 and 6 the idea of forming a pattern, design, or symbol with the tiles. In regard to claim 16, as broadly defined, the tiles (17) attach back portions (16, object) to the wire mesh.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newell, Jr. (U.S. Patent No. 1,004,810) as applied to claim 2 above and further in view of Snow et al. (U.S. Patent No. 6,669,175).

Newell, Jr. discloses the applicant's basic inventive concept except for making the material from a polymer sheet material. Snow et al. shows in figures 1-12 tiles that are made from a flexible, resilient polymer sheet material, see column 5, lines 1-8. In view of the teachings of Snow et al. it would have been obvious to one in the art to modify Newell, Jr. by making the tiles from a polymer sheet material since this would make the tiles more durable and weather resistant and would allow the tiles to be made in an easier and faster manner. In regard to claim 4, the applicant is not positively claiming the strand mesh so the shape of the openings is immaterial and further Newell, Jr. shows in figures 1 and 6 that the openings are generally square and shows in figure 9 that the tiles are generally square. In regard to claim 5, Newell, Jr. discloses the applicant's basic inventive concept except for whether the sides are 1.5 to 1.7 inches and the tabs extending .5 to about .75 inches from the sides. It would have been obvious to one in the art to modify Newell, Jr. by making the sides 1.5 to 1.7 inches and the tabs .5 to about .75 inches since this it is considered within one skilled in the art to make the sides and tabs any size as desired. Also, the Federal Circuit has held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984).

Claims 1-5 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snow et al. (U.S. Patent No. 6,669,175).

Snow et al. shows in figures 1-12 a flat tile (10) of a flexible, elastic material (column 5, lines 1-8) having a body portion in the shape of a parallelogram and tabs (the portions on opposite sides of the recesses 24,24,28,28). Snow et al. discloses the applicant's basic inventive concept except for whether the sides are 1 to 2-3/8 inches and the tabs extending 1/4 to 3/4 inches from the sides. It would have been obvious to one in the art to modify Snow et al. by making the sides 1 to 2-3/8 inches and the tabs 1/4 to 3/4 inches since this would allow the tiles to be secured to a typical sized wire mesh fence and further it is considered within one skilled in the art to make the sides and tabs any size as desired. Also, the Federal Circuit has held that where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device, see *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. Denied, 469 U.S. 830, 225 USPQ 232 (1984). In regard to claim 2, the tiles are deformable by hand. In regard to claim 3, the tiles (10) are formed of a polymer material, see column 5, lines 1-8. In regard to claim 4, the tiles are considered to be roughly square. In regard to claim 5, Snow et al. discloses the applicant's basic inventive concept except for whether the sides are 1.5 to 1.7 inches and the tabs extending .5 to about .75 inches from the sides. It would have been obvious to one in the art to modify Snow et al. by making the sides 1.5 to 1.7 inches and the tabs .5 to about .75 inches since this it is considered within one skilled in the art to make the sides and

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tabs any size as desired. In regard to claim 8, it is considered within one skilled in the art to modify Snow et al. by making the thickness of the tiles between .005 to .075 inches since this would allow the tiles to be flexible enough to flex onto the wire mesh and it is it considered within one skilled in the art to vary the thickness of the tiles as desired. In regard to claim 9, the tiles (10) are placed within openings in the mesh and as shown in figures 3,5,6, and 7 substantially cover the openings. In regard to claim 10, the wires form a chain link fence (12). In regard to claim 11, the body portion is substantially square. In regard to claims 13 and 15, Snow et al. shows in figure 12 the idea of forming a pattern, design, or symbol with the tiles. In regard to claim 16, as broadly defined, the tile (10) help to attach an object (one of the other tiles 10) to the wire mesh.

Response to Arguments

Applicant's arguments filed Feb. 18, 2005 have been fully considered but they are not persuasive.

The applicant argues that the tabs of Hisatomi et al. could not be greatly extended since the tabs of adjacent tiles would dislodge each other. The applicant defines in independent claims 1 and 14 that the tabs are "about $\frac{1}{4}$ to $\frac{3}{4}$ inch" from each side. The size of the tabs of Hisatomi et al. depends upon the diameter of the wire used to make the fence. In large diameter wire fences the recess in each side would be larger and deeper and the size of the tabs would be longer and would be "about $\frac{1}{4}$ inch" as broadly defined by the applicant. The applicant does not specifically define in the specification what dimensions are covered by the terms "about $\frac{1}{4}$ inch" so this

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phrase must be given its broadest reasonable interpretation. Therefore, 3/16 inches and possibly 1/8 inch would be included in this expression.

The applicant argues that the tongue 19 of Newell does not fit between a pair of parallel strand of the mesh, but instead fits around the strands, as illustrated in figure 10. The applicant fails to define in the claims that the tabs fit between a pair of parallel strands of the mesh. As broadly defined, the tongues (19) of Newell are capable of performing the functions defined by the applicant.

The applicant argues that it would not be obvious to adjust the size of Snow's tiles to the dimensions in the present claim. The examiner disagrees since the size of the tiles of Snow are based upon the size of the openings in a fence. For chain-link fences that include holes from 1/2 inch to 1 1/2 inches the tiles of Snow would fall within the parameters defined by the applicant in the claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
May 9, 2005